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10/723,586

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Michael D. Ellis

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EXAMINER

TAYLOR, JOSHUA D

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/723,586	Applicant(s) ELLIS ET AL.	
	Examiner JOSHUA TAYLOR	Art Unit 2426	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 200-219 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 200-219 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This Office Action is in response to a Request for Continued Examination entered on April 1, 2009 for the patent application 10/723,586 filed on November 24, 2003.

Status of Claims

2. Claims 200-219 are pending. Claims 1-199 and 220-229 have been canceled.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 200-202, 206-212 and 216-219 are rejected under 35 U.S.C. 103(a) as being unpatentable over Banker et al. (Pat. No.: US 5,485,221) in view of Windrem et al. (Pat. No.: US 5,754,730).

Examiner's Note: The following claims are rejected using Banker, which incorporates by reference Lett et al. (Pat. No.: US 5,592,551). For ease of reference, Examiner's citations will refer to the Banker text unless otherwise indicated. ¶ 11. below applies.

Regarding claims 200 and 210, Banker discloses **user television equipment and a method that allows a user to watch one television program on a viewing device while**

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simultaneously recording another television program (column 9, lines 33-51), **said user television equipment comprising: a storage device** (column 16, line 34. A VCR is a storage device.); **a first tuner** (Fig. 2, element 100) **coupled to said viewing device** (Fig. 1A, elements 14 and 20, column 5, lines 53-67. The subscriber terminal 14, shown in detail in Fig. 2, is coupled to the television.); **a second tuner coupled to said storage device** (column 9, lines 33-51 and column 16, lines 23-38. The VCR can record programming from the second tuner, and therefore must be coupled to it.). In the main body of the disclose of Banker, Banker discloses the subscriber terminal having an interactive user interface with an on-screen display (column 11, lines 10-25). However, in the Lett patent, which is incorporated by reference into the Banker patent (column 7, lines 8-12), there is a more in-depth disclose of interactive program guides. Thus, Banker further discloses **an interactive television program guide implemented on user television equipment** (Lett, Abstract, Figs. 2 and 3), **said interactive television program guide configured to: cause said viewing device to display a program guide display** (Lett, Fig. 4B); **receive a user selection to watch a first television program indicated on said program guide display** (Lett, column 11, line 67 – column 12, line 8); **receive a user selection to record a second television program indicated on said program guide display** (Lett, column 3, lines 1-8); **cause said first tuner to tune to a channel, corresponding to said first television program in order to cause said first television program to be displayed by said viewing device** (Lett, column 12, lines 19-27); **and cause said second tuner to tune to a channel corresponding to said second television program in order to cause said second television program to be recorded by said storage device** (Lett, column 12, lines 19-27), **wherein broadcast times of said first television program and said second television program overlap such that said first**

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television program is displayed by said viewing device at the same time that said second television program is recorded by said storage device (column 9, lines 33-51 and column 16, lines 23-38). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Banker to produce an electronic program guide from which the user could select to view one program while recording another program.

Banker does not explicitly disclose wherein the storage device which records the second television program is **a digital storage device**. However, in analogous art, Windrem discloses that a digital video recorder (DVR) can be used to record television content (Fig. 1, column 2, lines 13-27). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to substitute the VCR of Banker for the DVR of Windrem.

Regarding claims 201 and 211, the combined teachings of Banker and Windrem disclose **the user television equipment and method of claims 200 and 210**, and Banker further discloses **wherein said interactive television program guide is further configured to use said second tuner to perform a function other than program recording** (column 9, lines 33-51 and column 16, lines 23-38. The other tuner may be used for a picture-in-picture display.).

Regarding claims 202 and 212, the combined teachings of Banker and Windrem disclose **the user television equipment and method of claims 201 and 211**, and Banker further discloses **wherein said function other than program recording is selected from the group consisting of providing a picture-in-picture signal, collecting program guide data, browsing the Internet, and playing a music channel** (column 9, lines 33-51 and column 16, lines 23-38. The other tuner may be used for a picture-in-picture display.).

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Regarding claims 206 and 216, the combined teachings of Banker and Windrem disclose **the user television equipment and method of claims 200 and 210**, and Banker discloses **further comprising switching circuitry having a first input coupled to said first tuner, a second input coupled to said second tuner, a first output coupled to said viewing device, and a second output coupled to said storage device** (Fig. 1A, elements 14, 18 and 20), **wherein said interactive television program guide is further configured to cause said switching circuitry to dynamically couple said first tuner to said viewing device and to dynamically couple said second tuner to said storage device** (column 9, lines 33-51 and column 16, lines 23-38. The VCR can record programming from the second tuner, and therefore must be coupled to it.). Windrem discloses the digital recording device (Fig. 1, column 2, lines 13-27), and therefore these claims are rejected on the same grounds as claim 200.

Regarding claims 207 and 217, the combined teachings of Banker and Windrem disclose **the user television equipment and method of claims 200 and 210**, and Banker further discloses **wherein said interactive television program guide is configured to cause said viewing device to display a first program listing corresponding to said first television program and to display a second program listing corresponding to said second television program** (Lett, Figs. 4A-6. Lett discloses multiple programs, any of which could be the first and second programs.). These claims are rejected on the same grounds as claim 200.

Regarding claims 208 and 218, the combined teachings of Banker and Windrem disclose **the user television equipment and method of claims 207 and 217**, and Banker further discloses **wherein said interactive television program guide is configured to receive said user selection to watch said first television program from a remote control when said first**

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program listing is highlighted by a cursor and to receive said user selection to record said second television program from said remote control when said second program listing is highlighted by a cursor (Fig. 5, column 11, line 42 – column 12, line 8). These claims are rejected on the same grounds as claim 200.

Regarding claims 209 and 219, the combined teachings of Banker and Windrem disclose **the user television equipment and method of claims 200 and 210**, and Banker further discloses **wherein said first tuner and said second tuner are included in a single set-top box** (Fig. 2, column 9, lines 33-51. Banker states that subscriber terminal 14 can have multiple tuners, although they are not drawn in Fig. 2.).

4. Claims 203 and 213 are rejected under 35 U.S.C. 103(a) as being unpatentable over Banker et al. (Pat. No.: US 5,485,221) in view of Windrem et al. (Pat. No.: US 5,754,730), and further in view of Macrae et al. (Pat. No.: US 6,052,145).

Regarding claims 203 and 213, the combined teachings of Banker and Windrem disclose **the user television equipment and method of claims 201 and 211**, but do not disclose **wherein said interactive television program guide is configured to cause said second tuner to tune to said channel corresponding to said second television program when said second television program is about to begin regardless of whether said second tuner is being used to perform said function other than program recording when said second television program is about to begin**. However, in analogous art, Macrae discloses that a scheduled recording can be initiated by having the set-top box automatically change the channel, regardless of what channel is

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currently being tuned (Fig. 21, column 17, lines 21-37. Note: There appears to be a typographical error in this section of Macrae, as Fig. 24 is cited, but Fig. 21 is clearly being referring to.).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Banker and Windrem to allow for the guide to tune to the appropriate channel as it had been programmed to do. This would have produced predictable and desirable results, in that the program which the user scheduled to record would be recorded even if the tuner was tuned to a different channel when the recording was to start.

5. Claims 204 and 214 are rejected under 35 U.S.C. 103(a) as being unpatentable over Banker et al. (Pat. No.: US 5,485,221) in view of Windrem et al. (Pat. No.: US 5,754,730), and further in view of Ellis et al. (Pat. No.: US 5,986,650).

Regarding claims 204 and 214, the combined teachings of Banker and Windrem disclose **the user television equipment and method of claims 201 and 211**, but do not disclose **wherein said interactive television program guide is further configured to cause said viewing device to display an option to cancel recording of said second television program when said second tuner is being used to perform said function other than program recording at the time said second television program is about to begin**. However, in analogous art, Ellis discloses displaying a message just before a recording is scheduled to begin giving the user the option to cancel the recording (column 14, lines 27-36). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Banker and Windrem to allow for the user to be reminded before the recording begins of the approaching start of recording. This

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would have produced predictable and desirable results, as at would give the user the option of changing their mind if they not longer desired to record the scheduled program.

6. Claims 205 and 215 are rejected under 35 U.S.C. 103(a) as being unpatentable over Banker et al. (Pat. No.: US 5,485,221) in view of Windrem et al. (Pat. No.: US 5,754,730), and further in view of Tsumori et al. (Pat. No.: US 5,650,827).

Regarding claims 205 and 215, the combined teachings of Banker and Windrem disclose **the user television equipment and method of claims 201 and 211**, but do not disclose **wherein said interactive television program guide is further configured to cause said viewing device to display an option to cancel recording of said second television program when said function other than program recording is initiated during said recording of said second television programs**. However, in analogous art, Tsumori discloses that a user can select an option so that a channel is locked during recording, so that the channel cannot be inadvertently changed during recording (Fig. 4, element 36b3, Fig. 8a, element 36b33, column 16, lines 18-36), which gives the user the option of canceling a recording by turning the channel lock off. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Banker and Windrem to allow the user an option to cancel the recording after it had started. This would have produced predictable and desirable results, as at would give the user the option of changing their mind if they not longer desired to continue to record the scheduled program.

Response to Arguments

7. Applicant's arguments filed April 1, 2009 concerning Banker's lack of properly teaching a program guide have been considered but are moot in view of the new grounds of rejection, i.e. using teachings from the Lett reference which is incorporated by reference into Banker, but was not referenced in the previous Office Action, dated October 1, 2008.

Applicant's arguments on pages 6 and 7 concerning claims 209 and 219 have been fully considered but they are not persuasive. Applicant argues that **"Claims 209 and 219 include the following additional feature that patentably improves over Banker: 'said first tuner and said second tuner are included in a single set-top box.'" The Office Action alleges that this feature is disclosed by Banker at col. 9, lines 37-40 and FIG. 2. Applicants respectfully disagree. FIG. 2 shows only a single tuner 100. Banker at col. 9, lines 37-40 states that multiple tuners may be provided, however, Banker states that they are specifically not shown in the single subscriber terminal being discussed in the col. 9 passage. No other disclosure in Banker could be found of multiple tuners being provided in a single subscriber terminal. Instead, Banker specifically discusses using two subscriber terminals in order to provide picture-in-picture displays. (Banker, col. 16, lines 23-38.)"**

Examiner's Response:

¶ 11. below applies. No other disclosure than **"multiple tuners may be provided"** is needed. Banker disclosed that the subscriber terminal could have multiple tuners. The fact that the embodiment Banker chose to illustrate did not include multiple tuners does not negate the

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validity of the disclose; rather, Banker, in stating that the multiple tuners are not shown, is allowing for their existence while explaining that the figures do not explicitly show them.

Examination Considerations

8. The claims and only the claims form the metes and bounds of the invention. “Office personnel are to give the claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d, 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969)” (MPEP p 2100-8, c 2, l 45-48; p 2100-9, c 1, l 1-4). The Examiner has full latitude to interpret each claim in the broadest reasonable sense. Examiner will reference prior art using terminology familiar to one of ordinary skill in the art. Such an approach is broad in concept and can be either explicit or implicit in meaning.
9. Examiner’s Notes are provided with the cited references to prior art to assist the applicant to better understand the nature of the prior art, application of such prior art and, as appropriate, to further indicate other prior art that maybe applied in other office actions. Such comments are entirely consistent with the intent and spirit of compact prosecution. However, and unless otherwise stated, the Examiner’s Notes are not prior art but a link to prior art that one of ordinary skill in the art would find inherently appropriate.
10. Unless otherwise annotated, Examiner’s statements are to be interpreted in reference to that of one of ordinary skill in the art. Statements made in reference to the condition of the

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disclosure constitute, on the face of it, the basis and such would be obvious to one of ordinary skill in the art, establishing thereby an inherent prima facie statement.

11. Examiner's Opinion: ¶¶ 8.-10. apply. The Examiner has full latitude to interpret each claim in the broadest reasonable sense.

Conclusion

12. Claims 200-219 are rejected.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA TAYLOR whose telephone number is (571) 270-3755. The examiner can normally be reached on 8am-5pm, M-F, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hirl can be reached on (571) 272-3685. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Josh Taylor/

Examiner, Art Unit 2426

/Joseph P. Hirl/

Supervisory Patent Examiner, Art Unit 2426

June 12, 2009